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**PATENT****REMARKS**

Claims 1-21 are pending in the present application. In the above amendments, claims 1, 13, 16, 20 and 21 have been amended.

In the Office Action mailed September 19, 2005, the Examiner rejected claims 1, 16, 20, and 21 under 35 U.S.C. §102(e), as being anticipated by US Pub. 2003/0076801 by Aikawa et al. (hereinafter "Aikawa"). The Examiner rejected claims 2, 3, 12 and 17 under 35 U.S.C. §103(a) as being unpatentable over Aikawa. The Examiner rejected claims 4-6, and 14 under 35 U.S.C. §103(a) as being unpatentable over Aikawa in further view of US Pub. 2004/0100935 by Papageorngiou et al. (hereinafter "Papageorngiou"). The Examiner rejected claim 15 under 35 U.S.C. §103(a) as being unpatentable over Aikawa and further in view of Papageorngiou, further in view of US Pub. 2004/0161020 by Mathew et al. (hereinafter "Mathew"). The Examiner rejected claims 7 and 18 under 35 U.S.C. §103(a) as being unpatentable over Aikawa further in view of Mathew. The Examiner rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Aikawa, and Mathew, further in view of Papageorngiou. The Examiner rejected claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over Aikawa, further in view of Mathew and US Pub. 2003/0086512 by Rick et al (hereinafter "Rick"). The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Aikawa, and further in view of US Pub. 2004/0196893 by Oh et al. (hereinafter "Oh").

Claim 13 is objected to, as lacking antecedent basis. The specification is objected to as failing to provide proper antecedent basis for claims 5 and 6.

Applicants respectfully respond to this Office Action.

Claim 13 has been amended to clarify the existing antecedent basis of "the lapsed". Applicant believes that "an increase in the time lapsed", as originally filed, has sufficient antecedent basis. Nonetheless, the amendment is made to reduce the issues under consideration, and applicant believes the amendment does nothing to alter the scope of claim 13.

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## 35 U.S.C. §102

The standard for anticipation under §102 requires “the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim.” *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138, 231 U.S.P.Q.D (BNA) 644, 646 (Fed. Cir. 1998) (*quoting Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1101, 227 U.S.P.Q. (BNA) 337, 350 (Fed. Cir. 1985)) (*additional citations omitted*). As discussed further below, the Examiner has failed to identify each and every claim limitation, and has therefore failed to set forth a *prima facie* case for anticipation as required by §102.

With respect to claims 1, 16, 20, and 21, the Examiner asserts that Aikawa teaches “a cell search controller that correlates a received signal with a synchronization sequence to produce a first plurality of search results wherein each search result comprises at least one of an energy indicator or an offset ... and a processor for comparing the stored offset with the search result offset and deleting the corresponding search results from the first plurality of search results when the search result offset is within a predetermined threshold of the stored offset ...”. Applicants continue to respectfully disagree with the Examiner’s characterization of Aikawa. Aikawa teaches of extracting maximum correlation paths from detected paths during acquisition, and removing multipath components around the extracted maximum correlation paths. Nowhere does Aikawa teach of storing offsets, or of comparing a stored offset with a search result, or removing a corresponding search result from a plurality of search results when the search result is within a pre-determined threshold of the stored offset. This was pointed out in the Applicants’ amendment dated July 6, 2005. The Examiner has added additional citations within Aikawa purporting to show the claimed limitations. Again, Aikawa does not teach the claim limitations in the previously cited sections, nor in the newly cited sections (par. 52, 53, 69, 72, and FIG. 4 means 24), nor anywhere else, as far as Applicants can discern. Specifically, in responding to Applicants’ previous argument, the Examiner has failed to identify where Aikawa stores an offset for use in comparing. Thus, Aikawa does not teach each of the limitations of claims 1, 16, 20, or 21.

Applicant does not believe that the Examiner has met the requirements for rejecting claims 1, 16, 20 or 21 under §102. Nonetheless, to reduce the issues under consideration,

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Applicant has amended each claim to clarify the stored offset is "previously known", which highlights the distinction between the claims as presented and the teaching of Aikawa. As the Examiner has pointed out, Aikawa compares ones of the plurality of search results with one or more of the other plurality of search results, not with a stored offset. Support for this clarification can be found in an example embodiment described in paragraph [1050]. The claims as previously amended were in condition for allowance, and the amended claims are also. Applicant reserves the right to reintroduce the unamended claims in a future application.

## 35 U.S.C. §103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation of, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations.

For each §103(a) rejection in this Office Action, Applicants submit: the prior art of record does not provide a suggestion or motivation to modify the reference; there is not a reasonable expectation of success, and the reference does not teach or suggest all the claim limitations.

Each of the Examiner's rejections uses Aikawa as the basis for teaching one or more claimed elements. The arguments detailed above regarding Aikawa thus apply to each of these rejections as well. Thus, the *prima facie* case of obviousness is not made, as all of the claim limitations are not taught nor suggested. Various limitations in the dependent claims are also missing from the combined references, as illustrated in the previous amendment. Examples illustrating a few such omissions are given below. These examples are not exhaustive. Therefore, the rejections to claims 2-15 and 17-19 should be withdrawn.

Furthermore, the Examiner has failed to point out where the suggestion or motivation to combine the references is given. With respect to each combination, the Examiner states categorically that "it would have been obvious to one of ordinary skill in the art to combine the teaching" of the references. If the Examiner is relying on personal knowledge to support each

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finding of what is known in the art, including which documents to combine and how to do so, Applicants request that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding per 37 CFR 1.104(d)(2). Thus, the prima facie case of obviousness fails for lacking a suggestion to modify or combine reference teachings, and the rejections to claims 2-15 and 17-19 should be withdrawn for this reason as well.

With respect to claim 2, the Examiner asserts that Aikawa teaches "a plurality of scrambling code identifiers wherein the scrambling code identifiers are responsive to the multi-path deletion section 24 in which contains the predetermined offset table". The cited portions do not teach a memory, or a plurality of scrambling code identifiers, or a predetermined offset table. Again, the Examiner has mischaracterized Aikawa, in that it does not teach what the Examiner purports that it teaches. Importantly, the Examiner's characterization of Aikawa does not recite the limitations of claim 2. The Examiner has failed to assert that Aikawa teaches a memory for storing a first plurality of scrambling code identifiers and associated offsets, the stored offset selected therefrom. The Examiner also asserts that "one of ordinary skill in the art would clearly recognize that it is well known in the art to store data in a type of memory." The relevance of this statement is not apparent from Examiner's argument. It may be true, but it does not highlight how Aikawa teaches the limitations of claim 2. Nor is it taught in the references. If the Examiner is relying on personal knowledge to support this finding of what is known in the art, including how it relates to the limitations of claim 2, Applicants request that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding per 37 CFR 1.104(d)(2).

With respect to claim 13, the Examiner asserts that Aikawa fails to teach "the predetermined threshold is variable increasing with an increase in the time lapsed since the associated offset was determined." The Examiner states that combining Aikawa with Oh teaches "that the predetermined threshold is variable with an increase in the average noise power." Applicants point out that this purported teaching by Oh is not a limitation of claim 13. Neither does it state what the Examiner asserts is missing from Aikawa. Also, with respect to a motivation to combine, the Examiner posits that one of skill would combine the references "in order to assign the right scrambling code to the Rake receiver." Applicants note that this

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combination is not taught. Further, the relevance of this statement has not been identified by the Examiner, and the statement does not address limitations recited in claim 13.

With respect to the other cited references, Applicant refers again to arguments in the previous amendment, which have not been addressed or overcome by the Examiner's current rejection. Reconsideration in light of the foregoing arguments is requested. The arguments are omitted for the sake of brevity.

Thus, for these reasons, as well as additional arguments (not included herein), a prima facie case of obviousness has not been made, and the associated rejections should be withdrawn.

Specification

Applicant provides herewith amendments to the specification. The amendments to the specification are made by presenting new paragraphs for insertion relative to the immediate prior version.

With regard to the examiners objection to the specification, C.F.R. § 1.75 (d)(1) states:

(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

Applicant asserts that claims 5 and 6 find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. This support is identified in the previous amendment dated July 6, 2005. Nonetheless, to reduce the issues under consideration, the language of claims 5 and 6 was added to the specification following paragraph [1050].

Applicant believes these changes add no new matter to the application and are fully supported by the original disclosure.

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**REQUEST FOR ALLOWANCE**

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: 1/19/06

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